

Attorney Docket No. 310558.00003
Applicant: Eriksson et al.
Filing Date: 27 FEB 2004
Application No. 10/789,620
Date of Office Action: 31 JAN 2008
Response Date: 30 JULY 2008
Examiner: Michael G. Mendoza

REMARKS

In an Office Action mailed January 31, 2008, the Examiner rejected Claims 27-29 under 35 U.S.C. § 102(b) for alleged anticipation by Atkinson et al. (U.S. Patent No. 5,196,020), but imposed no other rejection under 35 U.S.C. §§ 102 or 103. The Examiner also provisionally rejected claims 1-32 for alleged obviousness-type double patenting over claims 1-44 of copending Application No. 11/398,185. Each issue raised by the Examiner is addressed below. Applicants canceled Claim 31 in the prior Response, and believe that the Examiner's provisional rejection of that claim is attributed to typographical or editing error. No claim amendment is presented. Reconsideration is respectfully requested.

The rejections under 35 U.S.C. § 102(b) are respectfully traversed. In the prior Response, Applicants canceled Claim 31, incorporated the subject matter of that claim into Claim 27 and changed the dependency of Claim 32. Because the Examiner had not rejected Claim 31 over the cited patent, Applicants believed that the incorporated subject matter put Claim 27 and its dependent claims into condition for allowance. Instead, the Examiner maintained the rejection of Claims 27-29 and asserted that

Claim 31 is essentially identical to the independent claim 27 with the acceptance (sic) of the limitation of the limitation (sic) "'placing the sliced tissue on the cutting surface'. However, it is inherent that the skin be placed on the cutting surface in order to be cut.

Applicants respectfully disagree that Claim 31 is 'essentially identical' to Claim 27. Former Claim 31 specified the additional method step of translating the device along the cutting surface in a second direction different than the first direction to cut through the sliced tissue and produce further sliced tissue. This additional method step, not shown in the cited patent, presumably provided the basis for not rejecting Claim 31 under §102 in the first Office Action. For this reason and absent any contrary basis for rejection, independent Claim 27 as previously presented is in condition for allowance.

The undersigned thanks Examiner Mendoza for discussing the outstanding Office Action by phone on July 29, 2008. The Examiner acknowledged that he had overlooked the additional

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recitations in Claim 31 and that he would favorably consider this argument as sufficient response to the outstanding rejections under §102.

The Examiner also acknowledged the inaccurate inclusion of Claim 31 in the provisional double-patenting rejection. To address the provisional double patenting rejection of the remaining claims, Applicants submit a Terminal Disclaimer, executed by the undersigned on behalf of Applicants. To ensure clarity in the record, a Power of Attorney in favor of the undersigned and others is also submitted, along with a Statement under Rule 3.73 from the Assignee.

A petition for an extension of time of three months accompanies this response so the response will be deemed to have been timely filed. Applicants also submit a Notice of Appeal to ensure that the application remains pending for a time sufficient to permit the Examiner to consider this response. Please charge the petition fee, the terminal disclaimer fee and the fee for the Notice of Appeal to Deposit Account number 17-0055. No other fee is believed due in connection with this response. However, should any such fee be due in this or any subsequent response, please consider this a request to charge the fee to the same deposit account.

Respectfully submitted,

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